REMARKS

Claims 1 to 33 are pending in the application. Claims 4 to 13, 17, 22 to 24, and 26 to 33 have been allowed. Claim 25 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing particularly to point out and distinctly to claim the subject matter that Applicants regard as the invention. Claims 1 to 3, 14 to 16, 18 to 21, and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Marritt (U.S. Patent 6,231,655) or Nyssen et al. (U.S. Patent 6,245,138) either in view of Maycock et al. (U.S. Patent 4,859,759) and Pearlstine et al. (U.S. Patent 6,087,416). Claims 1, 14 to 16, 18 to 21, and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Marritt or Nyssen et al. either in view of Meuwly et al. (U.S. Patent 5,837,792) and Pearlstine et al.

With respect to the rejection of claim 25 under §112, the Examiner has stated that the scope of newly added claim 25 is confusing because it appears to be identical to claim 16. Applicants have amended claim 25 to render it dependent from claim 22, thereby eliminating this basis for rejection. Applicants believe that this amendment also eliminates any possible basis for rejection of this claim under §103, since parent claim 22 has been allowed.

Applicants continue to traverse the rejections of claims 1 to 3, 14 to 16, and 18 to 21 under §103. In response to Applicants' arguments, the Examiner has stated that it is agreed that there is no disclosure of specific lightfastness agents in either Marritt or Nyssen et al., which is why each reference is used in combination with Pearlstine et al.

and either Maycock et al. or Meuwly et al. which teach a lightfastness as presently claimed.

Applicants remain of the position that one of ordinary skill in the art, even upon viewing these references in combination, would not be led to the instant invention as recited in claims 1 to 3, 14 to 16, and 18 to 21. The generalized teachings of light stabilizers or UV absorbers in these references would not lead one of ordinary skill in the art to an ink containing a molecule as recited in Formula I as recited in claim 1, wherein the molecule is a siloxane copolymer having both a hydrophilic moiety and a lightfastness moiety covalently bound thereto. One of ordinary skill in the art would not be motivated to combine the teachings of the references as the Examiner has done.

Further in response to Applicants' arguments, the Examiner has stated that it is agreed that Maycock et al. discloses siloxane which contains both a benzotriazolyl compound and a tatraalkylpiperidyl compound, but nothing in the scope of the present claims excludes the use of benzotriazolyl with attached tetraalkylpiperidyl.

Applicants point out that Maycock et al. teaches that the presence of both the benzotriazolyl component and the tetraalkylpiperidyl component are required to achieve the objectives of the invention disclosed therein, which are to provide a single molecule which absorbs ultraviolet radiation and inhibits actinic radiation-induced degradation and which rapidly segregates to the surfaces of fibers and films in a controllable manner upon melt extrusion of a composition comprising at least one such siloxane and at least one thermoplastic

polymer. One of ordinary skill in the art would not take from this reference, which is directed to plastics additives, any teaching that would lead to an invention as recited in instant claims 1 to 3, 14 to 16, and 18 to 21, which are directed to aqueous inks containing a siloxane copolymer having both a hydrophilic moiety and a lightfastness moiety covalently bound thereto. One of ordinary skill in the art would not be motivated to combine the teachings of the references as the Examiner has done.

Additionally, in response to Applicants' arguments, the Examiner has stated that while Maycock et al. and Meuwly et al. disclose lightfastness agents which are siloxanes that contain benzotriazolyl groups, neither reference discloses that the siloxane contains a hydrophilic moiety as presently claimed, and that for this reason each reference was used in combination with Pearlstine et al., which teaches attaching a hydrophilic group such as a polyalkylene oxide to a polysiloxane. In response to Applicants' argument that there is no motivation to combine Pearlstine et al. with Marritt et al. and either Maycock et al. or Meuwly et al. or with Nyssen et al. and either Maycock et al. or Meuwly et al., given that in Pearlstine et al. the waterfastness and lightfastness are achieved by selecting certain colorants, and the silicon surfactant is used to wet the surface of the substrate and not for lightfastness, the Examiner has stated that Pearlstine et al. is not used for its teaching of lightfastness agents, but only to teach modifying polysiloxanes with polyalkylene oxide groups to control the degree of compatibility which influences surface tension as well as to control the degree of polarity, and given that Maycock et al. and Meuwly et al.

disclose the use of polysiloxanes similar to those in Pearlstine et al. and given that Pearlstine et al. discloses that it is known to modify polysiloxanes with hydrophilic groups, there is good motivation to combine the cited references.

Applicants disagree with this position. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this invention should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure. In re Dow Chemical, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988). Marritt, Nyssen et al., and Pearlstine et al. are directed to aqueous inks for ink jet printing. Maycock et al. and Meuwly et al. are directed to light stabilization of plastics. The combination of references applied by the Examiner against the rejected claims do not suggest to one of ordinary skill in the art either that an ink as recited in the rejected claims should be made or that such an ink would have a reasonable likelihood of success.

The Examiner may be of the position that the invention claimed in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness is determined under 35 U.S.C. §103. In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); In re Yates, 211 U.S.P.Q. 1149 (CCPA 1981); In re Goodwin, 576 F.2d 375, 198 U.S.P.Q. 1 (CCPA 1978). Applicants direct attention to the decision in In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987). In this case, the invention was a method of

Inhibiting scale formation on and corrosion of metallic parts in cooling water systems by use of compositions containing (1) a sulfonated styrene/maleic anhydride (SSMA) copolymer, (2) a water soluble zinc compound, and (3) an organo-phosphorus acid compound or water soluble salt thereof. The Federal Circuit discussed three references cited against the claimed invention. The first, Ii, disclosed use in cooling water systems of scale and corrosion prevention compositions comprising a polymeric component in combination with one or more compounds selected from the group consisting of inorganic phosphoric acids and water soluble salts thereof, phosphonic acids and water soluble salts thereof, organic phosphoric acid esters and water soluble salts thereof, and polyvalent metal salts; the Ii polymeric component could contain maleic acid and styrene monomers, but there was no disclosure of the specific copolymer SSMA required in Geiger's claims. The second reference, Snyder '733, disclosed a method for treating cooling water systems prone to scale formation by the addition of a composition comprising an acrylic acid/lower alkyl/hydroxy acrylate copolymer and another polymeric component, which could be SSMA or a styrene/maleic anhydride copolymer; this reference noted that boiler and cooling water systems share a common problem in regard to scale deposit formation and that use of a styrene/maleic anhydride copolymer to prevent scale in boiler water systems was known. The third reference, Hwa, disclosed a method for treating boiler water systems that are prone to scale formation by addition of a composition comprising SSMA and an organo-phosphorus acid component. The Board had held that, based upon the prior art and the fact that each of

the three components of the composition used in the claimed method were conventionally employed in the art for treating cooling water systems, it would have been prima facie obvious, within the meaning of 35 U.S.C. §103, to employ these components in combination for their known functions and to optimize the amount of each additive. The Federal Circuit reversed, stating that li did not suggest use of SSMA as its claimed polymeric component and did not require the presence of an organophosphorus acid compound or a zinc compound, that although Snyder '733 disclosed the use of SSMA, it was for the purpose of showing that it, or one of three other specifically recited copolymers, could be used in combination with yet another polymeric component to prevent scale formation, and that while Hwa did disclose the specifically-recited organophosphorus acid compound, it provided no suggestion to add a zinc compound to its disclosed combination of SSMA and organophosphorus acid compounds, or to use SSMA in combination with an organophosphorus acid compound in the treatment of a cooling water system, where the characteristics could differ significantly from those in Hwa's boiler water system. The court concluded, "At best, in view of these disclosures, one skilled in the art might find it obvious to try various combinations of these known scale and corrosion prevention agents. However, this is not the standard of 35 U.S.C. §103." "With hindsight, we could perhaps agree that the Houghton article seems like an obvious place to start to address the need in the power plant industry for an improved carbon-catalyzed deoxygenation process employing hydrazine that can be used commercially in a variety of applications. But, "obvious to try" is not the standard." Ecolochem Inc. v. Southern

California Edison, 56 U.S.P.Q. 2d 1065, 1075 (Fed. Cir. 2000). Similarly, if the Examiner in the instant case is applying an "obvious to try" standard, Applicants point out that such is not the standard of §103.

Applicants believe that the foregoing amendments and distinctions place the claims in condition for allowance, and accordingly respectfully request reconsideration and withdrawal of all grounds for rejection.

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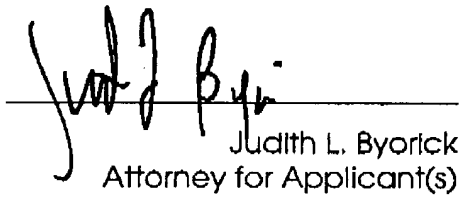
In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Applicant(s) attorney, Judith L. Byorick, at Telephone Number (585) 423-4564, Rochester, New York.

Respectfully submitted,



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